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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88674888
Applicant	Garan Services Corp.
Applied for Mark	MATCH STUDIO
Correspondence Address	G ROXANNE ELINGS DAVIS WRIGHT TREMAINE LLP 1251 AVENUE OF THE AMERICAS, 21ST FLOOR NEW YORK, NY 10020 UNITED STATES Primary Email: NYC-Trademark@dwt.com Secondary Email(s): RoxanneElings@dwt.com, OrrinFalby@dwt.com, VloraBacaj@dwt.com, KoriTurrubiate@dwt.com 212 489-8230
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Filer's Name	G. Roxanne Elings
Filer's email	NYC-Trademark@dwt.com, RoxanneElings@dwt.com, OrrinFalby@dwt.com, VloraBacaj@dwt.com
Signature	/GRE/
Date	06/07/2021

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Garan Services Corp.

Serial No.: 88674888

Mark: **MATCH STUDIO**

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APPLICANT'S APPEAL BRIEF

G. Roxanne Elings
Davis Wright Tremaine, LLP
1251 Avenue of the Americas
21st Floor
New York, NY 10020
(212) 489-8230

Attorneys for Applicant

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Applicant Garan Services Corp. appeals from the August 13, 2020 Office Action, making final the Examining Attorney's refusal of Applicant's application for the mark MATCH STUDIO, and from the March 8, 2021 decision denying Applicant's Request for Reconsideration of the final refusal.

I. SUMMARY OF PROCEEDINGS BELOW

Application Serial No. 88674888 for the mark MATCH STUDIO for use in connection with "Clothing, namely, tops and bottoms," in International Class 025, was filed on October 31, 2019. On February 10, 2020, a non-final office action was issued under §2(d) of the Lanham Act, 15 U.S.C. §1052(d) (the "Non-Final Office Action"), on the grounds that the applied-for mark is likely to cause confusion with the marks identified in the chart below (the "Cited Registrations" or "Cited Marks"):

MARK PARTICULARS	GOODS
 Reg. No. 4808153	Class 25: Clothing and accessories for babies, adults, children, women and men, namely, caps; caps with visors; hats; beanies; coats for men, women and children, namely, coats made of cotton, heavy coats, over coats, rain coats; jackets for men, women and children, namely, outer jackets, rain proof jackets; denim pants; woven bottoms and tops; wearable garments and clothing, namely, shirts for adults, children, women and men, namely, button down shirts, collared shirts, dress shirts, crew necks, knit shirts, knit tops, long sleeve and short sleeve shirts, long and short sleeve t-shirts, tank tops, long sleeve pullovers; cardigans; crew neck sweaters; sweaters; v-neck sweaters; sweatshirts for babies, adults, children, women and men; hooded sweatshirts for babies, adults, children, women, men.
MATCH Reg. No. 4808154	

The Examining Attorney concluded that "the applied-for mark merely adds descriptive wording onto the registrant's marks. The registered marks consist of the word "MATCH" whereas the applied-for mark adds the wording "STUDIO" onto these marks. Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d)." See, Non-

Office Action. As to the cited design mark, the Examining Attorney stated that, “although one of the registered marks contains a design element, this does not take significantly differentiate the marks from one another for two reasons. First, when evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods.” *Id.*

Applicant timely filed its response to the non-final office action on August 10, 2020 (the “Office Action response”) arguing that the term MATCH is weak, in that it is highly suggestive of the named goods based on the dictionary definition of the word and submitted more than fifty (50) extant third-party published applications and registrations for MATCH-formative marks covering Class 25 goods.

On August 13, 2020, the Examining Attorney made final the refusal to register (the “Final Office Action”) stating that (i) “the applied-for mark merely adds descriptive wording onto the registrant’s marks [and] . . . [a]dding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case . . .;” and (ii) “although one of the registered marks contains a design element, this does not take significantly differentiate the marks . . . [because] when evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods.”

On February 16, 2021, Applicant simultaneously filed a Request for Reconsideration of the Final Office Action and a Notice of Appeal. In its Request for Reconsideration, Applicant

submitted sample webpages demonstrating at least 24 uses of the term MATCH in connection with apparel goods.

On March 8, 2021, the Examining Attorney issued the “Reconsideration Letter” maintaining the refusal stating, “applicant asserts that the trademark examining attorney has cited to no authority for the proposition that the addition of a descriptive element to an otherwise highly suggestive mark is insufficient to obviate the likelihood of confusion.” In actuality, the trademark examining attorney did not agree that the word “MATCH” was “highly suggestive,” but instead acknowledged that the wording “could have suggestive meaning,” and clarified that “the Board has recognized that highly suggestive marks *may* be entitled to a narrower scope of protection than an entirely arbitrary or coined word.” However, no consideration was given the evidence of third-party uses Applicant submitted.

II. ARGUMENT

The Examining Attorney has concluded that Applicant's mark is similar in appearance, sound, connotation and commercial impression to the Cited Marks, based solely on the fact that all of the marks at issue contain the term MATCH. In finding that a likelihood of confusion exists, the Examining Attorney has stated that the word MATCH is not highly suggestive, but instead it “**could have suggestive meaning.**” See, Reconsideration Letter. The Examining Attorney clearly ignores the probative and substantial evidence made of record by Applicant, namely, the registration and use by numerous third-parties of marks that include the common element in connection with apparel goods, in his effort to support an erroneous conclusion concerning the distinctiveness of the term MATCH and scope of protection it should be afforded. Applicant respectfully submits that there is no reasonable basis upon which the Examining Attorney can concluded the term MATCH **is not** highly suggestive. *Id.*

The evidence that MATCH is weak and highly suggestive when used in connection with apparel goods is clear and convincing. Applicant has submitted over fifty (50) published applications and registration for marks that include the term MATCH in Class 25. See, Office Action response at Exhibit B. Additionally, Applicant has submitted dictionary definitions further demonstrating that MATCH has a commonly understood connotation and connection to apparel goods. *Id.* at Exhibit A. Furthermore, Applicant has submitted twenty-four examples of third-parties using the word MATCH in their trademarks in connection with apparel goods. See, Request for Reconsideration at Exhibit A.

Moreover, the Examining Attorney ignores the additional distinguishing elements in the marks and has improperly dissected Applicant's mark failing to not give consideration to the effect the additional element STUDIO has on the MATCH portion or the effect of the design element in one of the Cited Marks.

Applicant therefore submits that the Examining Attorney's decision is erroneous as a matter of law and for the reasons set forth below, it should be reversed and Applicant's mark should be allowed to register.

**A. “MATCH” is Highly Suggestive and Weak
When Used in Connection With Clothing**

It is well established that, if the common element of two marks is “weak”, in that it is highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality. *See, e.g., In re Bed & Breakfast Registry*, 229 USPQ 818 (Fed. Cir. 1986); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985); and *In re Istituto Sieroiterapico E Vaccinogeno, Toscano “SCLAVO” S.p.A.*, 226 USPQ 1035 (TTAB 1985). The Board has recognized that highly suggestive marks may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See,*

In re Box Solutions Corp., 79 USPQ 2d 1953 (TTAB 2006); and *In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984).

Third-party registrations, *inter alia*, may be used to show that the common portion of allegedly conflicting marks has a normally understood and well-known meaning, and that this has been recognized by the Trademark Office by granting registrations containing such common element for the same or closely related goods/services, where the remaining portions of the marks are sufficient to distinguish the marks as a whole. *American Hospital Supply Corp. v. Air Products and Chemicals, Inc.*, 194 USPQ 340 (TTAB 1997); *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1467 (TTAB 1990); *Knight Textile Corporation v. Jones Investment Co., Inc.*, 75 USPQ2d 1313 (TTAB 2005); *Tektronix Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976), *aff'g* 187 USPQ 588 (TTAB 1975), *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 USPQ 422, 424-25 (CCPA 1975); and *In Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ 2d 1404 (TTAB 1988). In other words, the Trademark Office can determine that a mark is highly suggestive by looking to the presence of multiple other registrations with common elements in the same class of goods/services. *See, e.g., General Mills v. Health Valley Foods*, 24 USPQ2d 1270, 1278 (TTAB 1992).

According to the Merriam-Webster dictionary, one of the definitions for “match” as a noun is “a pair suitably associated // carpet and curtains are a match.” See Office Action Response, Exhibit A. Three of the examples showing “match” as used in a sentence provided by the dictionary relate specifically to clothing, namely: (1) “She was wearing a beautiful skirt, but her sweater didn’t *match* it;” (2) “Her skirt and sweater *matched* perfectly”; and (3) “Your socks don’t *match* each other.” This definition is suggestive of desirable qualities or effects for apparel goods.

This highly suggestive significance of the term MATCH when used with apparel goods as demonstrated by the dictionary definition is corroborated by the plethora of coexisting third-party published applications and registrations Applicant has identified and made of record that cover various types of apparel goods. *Id.* at Exhibit B. The more than 50 applications and registrations show that others in the field have considered MATCH to have significance when applied to apparel.

For example, the following are marks where the term MATCH appears as the dominant portion currently coexist on the Register for apparel goods: MATCHES (Reg. No. 5755083); MATCH MUCH (Reg. No. 5236631); MATCH-RIGHT (Reg. No. 5160604); MATCH in Chinese characters (Reg. No. 4830509); MATCH 7 (Reg. NO. 5207641); WE MATCH! (Reg. No. 4707277); SURE-MATCH (Reg. No. 4421820); MATCHES FASHION (Reg. No. 4566025); MATCH ME (Reg. No. 3234738); EZ MATCH (Reg. No. 2673300); COLOR MATCH (Reg. No. 1592084); MATCH 5 TRIVIA (App. No. 88867061); MATCH MY STATUS (App. No. 88748091); EB MATCH (Reg. No. 5546857); MATCH PLAY (Reg. No. 5926857); MATCH POINT (Reg. No. 5030622); MATCHSPORTS (Reg. No. 5409414); MATCH TUFF (Reg. No. 5087905); MATCH. MEET. KLIQUE. (Reg. No. 4895073); and MATCHFIT (Reg. No. 4884744).¹ Additionally, Applicant has made of record sample webpages demonstrating at least 24 uses of the term MATCH as source indicator (E.g.: MATCH APPAREL, MATCH UP APPAREL, MISS MATCH, MATCH MY FLY CLOTHING APPAREL, and MATCH JERSEY T-SHIRT).

As in *Knight Textile*, the relevant issue in the case at hand is the strength or weakness of the common element of the marks. In concluding that ESSENTIALS was highly suggestive and

¹ Applicant submitted evidence of use of some of these marks in support of the Request for reconsideration.

subject to limited protection, the Board in *Knight Textile* relied primarily on a dictionary definition for “essential-s” and “twenty-three extant ESSENTIAL registrations on the register in the clothing field registered to twenty-one different owners.” *Knight Textile*, 75 USPQ2d at 1316. The Federal Circuit has held that extensive registration and use of a term by others can be powerful evidence of a term’s weakness as a mark or part of a mark. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

The number of third-party uses presented in this case is in line with what has been relied upon by the Federal Circuit in previously finding weakness based on extensive third party use of the same or similar term. Indeed, the Federal Circuit has twice characterized evidence of third-party use as “powerful on its face,” for purposes of demonstrating weakness, based on fewer third-party uses than what we have before us in this case. *See Jack Wolfskin*, 116 USPQ2d at 1136 (paw print found weak in connection with clothing based on a record comprising 14 third-party registrations and uses of paw print marks); and *Juice Generation*, 115 USPQ2d at 1674 (26 third party registrations and uses of marks containing the words “Peace” and “Love”).

Each of the *du Pont* factors may, in any particular case, play a dominant role in the likelihood of confusion analysis. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, Kellogg Co. v. Pack’em Enterprises Inc.*, 21 USPQ2d 1142 (Fed. Cir. 1991). In the present case, the weakness of the alleged dominant element in cited marks deserves significant weight in the analysis. As the Court stated in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 117 USPQ 295, 297 (CCPA 1958):

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection

afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Based on the evidence of record in this case, it is respectfully submitted that the consuming public is able to distinguish amongst the parties' marks by looking to other distinguishing elements of the marks.

**B. The Presence of one Common Element in the Marks
does not Render the Marks Confusingly Similar**

It is well established that, there is no rule that confusion is automatically likely simply because marks share common elements. *See e.g., Colgate-Palmolive Company v. Carter Wallace Inc.*, 167 USPQ 529, 530 (CCPA 1970) (PEAK PERIOD for personal deodorants not confusingly similar to PEAK for dentifrice); and *Lever Brothers Company v. The Barcolene Company*, 174 USPQ 392 (CCPA 1972) (ALL CLEAR for household cleaner not likely to cause confusion with ALL for same goods). Even if a particular feature of the marks was to create a separate commercial impression apart from the other elements of the marks, any alleged confusing similarity would not be determinative with respect to the marks in their entirety. *See, Massey Junior College, Inc. v. Fashion Institute of Tech.*, 181 USPQ 272, 276 (CCPA 1974) (there is no rule that confusion is automatically likely if a junior user has a mark that contains in part the whole of another's mark). The proper test in determining likelihood of confusion must be based on the similarity or dissimilarity of the general overall commercial impressions engendered by the involved marks. *See, Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); *Grandpa Pigeon's of Missouri, Inc. v. Borgsmiller*, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants Inc. v. Morrison, Inc.*, 23 USPQ 2d 1735 (TTAB 1991), *aff'd. unpub'd.* (Fed. Cir. June 5, 1992).

Thus, marks must be considered in their entirety because the commercial impression of the marks on the consumer is created by the marks as a whole, not by their respective component parts. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). Where there are both similarities and differences in the marks, these must be weighed against one another to determine which predominates. *Price Candy Co. v. Gold Metal Candy Corp.*, 105 USPQ 266 (CCPA 1955).

In the instant matter, the Examining Attorney has concluded that the cited marks, two marks that currently coexist with at fifty (50) others on the Register that contain the common element MATCH creates the same or a similar commercial impression as Applicant's mark MATCH STUDIO. In reaching this conclusion, however, it appears that the Examining Attorney has improperly dissected the marks and has given no consideration to the significance of the additional elements that comprise the marks. As it is improper to focus on any particular feature, while ignoring all other elements of the mark to find a likelihood of confusion, it is respectfully submitted that the Examining Attorney's conclusion that the marks are similar is based on an erroneous premise.

The Examining Attorney has cited to no authority for the proposition that the addition of a descriptive element to an otherwise highly suggestive mark is insufficient to obviate the likelihood of confusion. In fact, the cases cited by the Examining Attorney in support of this proposition are clearly distinguishable on their facts. In *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (CCPA 1975) (BENGAL and BENGAL LANCER and design are confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); and *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO

and MACHO COMBOS confusingly similar), none of the common elements in each of the cited marks was deemed to be highly suggestive. They were in the least arbitrary designations and entitled to a broad scope of protection. Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding a house mark or other distinctive matter. *See e.g., Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

Contrary to the Examining Attorney's position however, the addition of matter to a mark may be sufficient to avoid a likelihood of confusion, **if the common portion of the marks is weak because it is merely descriptive or diluted**. There are numerous decisions wherein the TTAB and its predecessor court have concluded that the addition of a descriptive element to a highly suggestive or diluted term is sufficient to distinguish the marks in the marketplace. *See, e.g., Pizza Inn, Inc. v. Russo*, 221 USPQ 281 (TTAB) (dismissing an opposition where numerous parties used "little Italian men" or "pizza men" for food related goods and services); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) (reversing refusal of BROADWAY CHICKEN where Examining Attorney had cited registrations for BROADWAY PIZZA and BROADWAY BAR & PIZZA); *Conde Nast Publ'ns., Inc. v. Miss Quality, Inc.*, 507 F.2d 140, 184 USPQ 422 (CCPA 1975) (COUNTRY VOGUES for "ladies' and misses' dresses" held not likely to be confused with VOGUE for "a magazine" based, in part, on evidence of sixty-nine third-party registrations for marks which include VOGUE); and *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (CAPITAL CITY BANK for banking and financial services and CITIBANK for the same services not likely to cause confusion, based in part on finding that the phrase "City Bank" was frequently used in the banking industry).

When considering the respective marks at issue in their entirety, it is respectfully submitted that the marks are more dissimilar, rather than similar, in appearance, sound, connotation, and overall commercial impression – the only similarity being that all of the marks contain the word MATCH. The additional elements that form each mark are significant and distinguishing features, the nature and character of which and their reaction with the common portion must be considered when viewing marks in their entirety. *See e.g., Guerlain, Inc. v. Richardson-Merrell Inc.*, 189 USPQ 116, 119 (TTAB 1975) (“The fact that two marks have common letters does not mean that the marks as a whole project the same commercial impression. The nature and character of the remaining portion or portions and their reaction with the common initial letters must be considered”); *The O.M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352, 356 (TTAB 1976) (No likelihood of confusion between ASCOT and SCOTTS used in connection with identical goods.)

The marks in this case are similar only to the extent that they contain the term MATCH, a highly suggestive and weak term when used in connection with the parties’ goods as demonstrated, *supra*. At least one of the cited marks contains additional design elements, namely, seven stylized matchsticks, one that runs in a straight vertical line through the center of the word “MATCH” and six others, three to either side of the central vertical stylized matchstick, that are increasingly curved in an outward facing direction the further each such stylized matchstick is from the central vertical stylized matchstick, which are inextricably intertwined with the common element MATCH and inseparable therefrom for the purpose of a Section 2(d) analysis.

Applicant’s mark, on the other hand, contains at least two elements amounting to 5 syllables. Applicant’s mark is pronounced with sound and cadence that is distinct from the cited

marks and have a different connotation and overall commercial impression. Where the common element of two marks is weak, it is unlikely that consumers will be confused unless the marks have other commonality. *Juice Generation*, 115 USPQ2d at 1674-75. Therefore, the addition of the term STUDIO to the applied-for mark and the design element one of the Cited Mark cannot be ignored. These elements sufficiently distinguishes the parties' marks in the marketplace and the consumer is able to differentiate between them as they have become accustomed seeing multiple MATCH-formative marks used in connection with apparel goods.

Taking into consideration the highly suggestive nature and relative weakness of the common elements in cited marks and the difference in the appearances, phonetics, connotation and commercial impressions, there is no likelihood of confusion. Contemporaneous use of the subject marks is not likely to cause confusion in the marketplace, based solely on the dissimilarity of the marks. *See, Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 47 USPQ 2d 1459, 1460-61 (Fed. Cir. 1998) (Board, in finding no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, did not err in relying solely on dissimilarity of marks).

III. CONCLUSION

In light thereof, Applicant respectfully requests that the Board reverses the final refusal under §2(d) of the Lanham Act and allow Applicant's application to proceed to publication.

DATED: New York, New York
June 7, 2021

Respectfully submitted,

DAVIS WRIGHT TREMAINE LLP

/GRE/

By: G. Roxanne Elings
1251 Avenue of the Americas, 21st Floor
New York, New York 10020
(212) 489-8230